

REMARKS

In the Office Action dated December 20, 2005, claims 1, 3-7, and 40-42 were rejected under § 103 over U.S. Patent No. 4,839,644 (Safinya) in view of over U.S. Patent No. 5,172,112 (Jennings); claims 2, 10, 11, 14, 19-24, 44-46, 51, 67, and 69 were rejected under § 103 over Safinya in view of Jennings and U.S. Patent No. 6,603,977 (Walsh); claims 1, 8, 9, 16-19, 23, 28, 29, 39, 40, 43, 47, 49, and 68 were rejected under § 103 over U.S. Patent No. 6,192,980 (Tubel) in view of Jennings and Walsh; claim 48 was rejected under § 103 over Tubel in view of Jennings, Walsh, and U.S. Patent No. 4,578,575 (MacLeod); and claims 52-55 were rejected under § 103 over Jennings in view of U.S. Patent no. 6,655,453 (Head).

Applicant acknowledges the allowance of claims 33, 56, and 59-66.

It is respectfully submitted that the obviousness rejection of claims 52-55 over Jennings and Head is improper. Head does not qualify as prior art against the present invention. Note that the present application claims the benefit under § 119(e) of U.S. Provisional Application Serial No. 60/333,950, which was filed on November 28, 2001. The filing date of Head is November 28, 2001 – therefore, Head does *not* qualify as prior art against the present application.

Withdrawal of the § 103 rejection of claims 52-55 over Jennings and Head is respectfully requested.¹

Independent claim 1 was rejected as being obvious over Safinya and Jennings. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1 for at least the reason that no motivation or suggestion existed to combine the teachings of Safinya and Jennings. See M.P.E.P. § 2143 (8th ed., Rev. 3), at 2100-135.

¹ It is also respectfully submitted that even if Head qualified as prior art, there existed no motivation or suggestion to combine the teachings of Jennings and Head. The cited passage (column 7, lines 20-29) of Head refers to an inductive link connection between a fishing socket 142 and a plug 138 to perform data transfer in a wellbore. However, such teaching has nothing to do with the teachings of Jennings regarding light-based communications between a stationery unit 15 and a moveable unit 19 (depicted in Figs. 2 and 3 of Jennings). Thus, a person of ordinary skill in the art would not have been motivated to combine the teachings of Jennings and Head.

The Office Action conceded that Safinya does not disclose short-range wireless communication. However, reliance was made on Jennings as disclosing “short-range wireless communication.” 12/20/2005 Office Action at 2. The communication mechanism used in Jennings is a laser-based communications system, where laser 45 in a moveable unit 19 is used to beam light over to a photocell 37 in a fixed unit 15. Jennings, 3:47-49. To allow the light communication between the moveable unit 19 and the fixed unit 15, the moveable unit 19 has to be located right next to the stationery unit 15. There would have been no reason to incorporate the laser-based communications mechanism of Jennings into the system of Safinya. In Safinya, a downhole component includes a toroidal antenna 149 for communication through an annulus region filled with fluid to a remote uphole antenna 161 located at the earth surface. As stated by Safinya, the annulus region 20 is filled with a non-conductive dielectric so that “transmissions over relatively long distances (more than few hundred feet)” will not suffer high attenuation. Safinya, 5:57-67. Thus, what is contemplated in Safinya is long-distance communications in an annulus region 20 filled with non-conductive fluid between an uphole antenna and a downhole antenna. Incorporating the laser-based communications mechanism of Jennings into the system of Safinya would render the Safinya system inoperable for its intended purpose, which is to enable communications between the downhole component and the uphole component through an annulus region 20 filled with fluid. This is a clear indication that no motivation or suggestion existed to modify the teachings of Safinya with the teachings of Jennings. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 over Safinya and Jennings.

Independent claim 1 was also rejected as being obvious over Tubel, Jennings, and Walsh. Tubel discloses a system for controlling and/or monitoring a plurality of production wells from a *remote location*. Tubel, Abstract. A downhole control system 22 in Tubel interfaces with a surface system 24 using a wireless communications system or an electrical wire. Tubel, 9:46-48. Thus, what is contemplated in Tubel is long distance communications between the downhole control system 22 and the surface system 24. Modifying the Tubel system with the laser-based communications mechanism of Jennings would render the Tubel system inoperative for its intended purpose, which is to enable communications between the downhole control system 22 and the surface system 24. Therefore, no motivation existed to combine Tubel with Jennings.

Also, Walsh relates to a location information system for locating a wireless caller for emergency 911 purposes. There is absolutely no suggestion whatsoever in Walsh of modifying the communications systems for use in production wells as described in Tubel in the manner proposed by the Office Action. In view of the foregoing, it is clear that no motivation or suggestion existed to combine Tubel, Jennings, and Walsh to achieve the subject matter of claim 1. Therefore, a *prima facie* case of obviousness has also not been established with respect to claim 1 over Tubel, Jennings, and Walsh.

Independent claim 39 is allowable over Tubel, Jennings, and Walsh for similar reasons.

Independent claim 2 was rejected as being obvious over Safinya, Jennings, and Walsh. The Office Action conceded that neither Safinya nor Jennings teaches use of a Bluetooth wireless communication protocol. However, the Office Action stated that use of the Bluetooth wireless communication protocol as recited in claim 2 would be obvious, relying upon Walsh. 12/20/2005 Office Action at 3. It is respectfully submitted that no motivation or suggestion existed to combine the teachings of Safinya, Jennings, and Walsh. The Office Action has cited no evidence that would have led a person of ordinary skill in the art to modify the Safinya/Jennings system with Bluetooth. Walsh relates to use of Bluetooth in the context of locating a wireless user for emergency 911 purposes. There is absolutely no suggestion in Walsh that it would even be desirable to incorporate Bluetooth into the Safinya/Jennings system. In fact, not only was there no motivation or suggestion to incorporate the teachings of Walsh into the Safinya/Jennings system, it is respectfully submitted that the Office Action has not provided any evidence that there would be a reasonable expectation of success in using Bluetooth in the Safinya system. *See* M.P.E.P. § 2143, at 2100-135 ("There must be a reasonable expectation of success."). Due to the arrangement of Safinya, it is unlikely that Bluetooth can be properly used in the Safinya system. In fact, it is likely that use of Bluetooth in Safinya would render the system of Safinya inoperative for its intended purpose. Therefore, a *prima facie* case of obviousness has not been asserted against claim 2 over Safinya, Jennings, and Walsh.

Independent claim 51 is also similarly allowable over Safinya, Jennings, and Walsh.

Independent claim 40 was rejected as being obvious over Safinya and Jennings. Note that claim 40 recites use of a Bluetooth wireless communication protocol, which was conceded as neither suggested by Safinya and Jennings. Therefore, withdrawal of the rejection of claim 40 is respectfully requested.

Independent claim 40 was also rejected as being obvious over Tubel, Jennings, and Walsh. In view of the discussion above with respect to claim 1, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 40 over Tubel, Jennings, and Walsh.

It is respectfully submitted that no rejection was asserted against claim 58. Allowance of claim 58 is therefore respectfully requested.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the fact that the rejection of base claims has been overcome, it is respectfully submitted that the obviousness rejections of dependent claims have also been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0270US).

Respectfully submitted,

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